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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/786,050

02/26/2004

Yoshihiro Ogawa

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EXAMINER

NOTE, JANIS L

ART UNIT

PAPER NUMBER

1795

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/786,050	Applicant(s) OGAWA ET AL.	
	Examiner Janis L. Dote	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1795

1. The examiner acknowledges the amendment to claim 1 filed on Oct. 5, 2007. Claims 1, 4-6, 10, and 11 are pending.

2. The examiner notes that the term "average circularity" is defined at page 48, lines 1-13, as the "value determined by dividing the sum of measured circularity values of total particles having equivalent circle diameters of 3  $\mu\text{m}$  to 400  $\mu\text{m}$ , by the number of total particles," where the circularity is defined as  $L_o/L$  where " $L_o$  represents a circumferential length of a circle having an area identical to that of a projected particle image, and  $L$  represents a circumferential length of the projected particle image processed at an image processing resolution of 512 x 512 (0.3  $\mu\text{m}$  X 0.3  $\mu\text{m}$  pixel)."

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. US 7,029,813 B2 (Mikuriya) has an effective filing date of Nov. 21, 2003, which is prior to the instant specification filing date of Feb. 26, 2004. The inventive entity of Mikuriya differs from that of the instant specification. Accordingly, Mikuriya qualifies as prior art under 35 U.S.C. 102(e).

Applicants have not perfected their claim to foreign priority under 35 U.S.C. 119 to Japanese patent application No. 2003-203863. The verified English-language translation of the priority document filed on Jul. 20, 2005, does not provide an adequate written description of the subject matter recited in instant claim 1 as required under 35 U.S.C. 112, first paragraph. The translation does not disclose that the polyester component comprises "a compound having a structure containing oxyalkylene ether of a novolak phenolic resin as an alcohol component" as broadly recited in instant claim 1. Rather, the translation describes the preparation of the polyester component by condensation polymerization between a polyhydric alcohol and a polycarboxylic acid, where the polyhydric alcohol can be a polyhydric alcohol component with 3 or more hydroxyl groups. The translation further describes that "preferred examples of the polyhydric alcohol component with 3 or more hydroxyl groups include a compound having a structure containing oxyalkylene ether of a novolak type phenolic resin. A compound having a structure containing oxyalkylene ether of a novolak type phenolic resin is a reaction product of a novolak type phenolic resin and a compound having one epoxy ring in the molecule, and has 3 or more alcohol hydroxyl groups at its terminal." See the translation, pages 19, 21, and 22, paragraphs 0039, 0044,

Art Unit: 1795

and 0046. In other words, the translation describes a compound having a structure containing oxyalkylene ether of a novolak phenolic resin having 3 or more hydroxyl groups. The compound recited in instant claim 1 is broader than that described in the translation because it includes compounds that have less than 3 hydroxyl groups.

5. Claims 1, 4, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,029,813 B2 (Mikuriya) combined with US 5,294,682 (Fukuda), US 6,475,687 B1 (Hayashi'687), and Karaki, as evidenced by applicants' admission at page 38, line 10, to page 40, line 1, of the instant specification (applicants' admission I).

The claims are rejected for the reasons discussed in the office action mailed on Jun. 5, 2007, paragraph 7, which are incorporated herein by reference.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mikuriya combined with Fukuda, Hayashi'687, and Karaki, as evidenced by applicants' admission I, as applied to claim 1 above, further combined with US 6,197,470 B1 (Tamura).

Art Unit: 1795

The claim is rejected for the reasons discussed in the office action mailed on Jun. 5, 2007, paragraph 8, which are incorporated herein by reference.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mikuriya combined with Fukuda, Hayashi'687, and Karaki, as evidenced by applicants' admission I, as applied to claim 1 above, further combined with additional teachings in Mikuriya.

The claim is rejected for the reasons discussed in the office action mailed on Jun. 5, 2007, paragraph 9, which are incorporated herein by reference.

8. Applicants' arguments filed on Oct. 5, 2007, applicable to the rejections over Mikuriya in paragraphs 5-7 above have been fully considered but they are not persuasive.

Applicants assert that Mikuriya is no longer prior art to the subject matter recited in the instant claims. Applicants assert that by deleting the phrase "hydrates thereof" in claim 1 in the amendment filed on Oct. 5, 2007, the verified English-language translation of the priority document Japanese patent application No. 2003-203863 filed on Jul. 20, 2005, provides an

Art Unit: 1795

adequate written description of the subject matter recited in instant claim 1.

However, for the reasons discussed in paragraph 4 above, the verified translation does not provide an adequate written description of the subject matter recited in instant claim 1. Accordingly, the rejections of claims 1, 4, 5, 10, and 11 over Mikuriya combined with the teachings of the other cited references stand.

9. Claims 1, 4, and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of Mikuriya in view of Fukuda, Tamura, Hayashi'687, and Karaki, as evidenced by applicants' admission I.

The claims are rejected for the reasons discussed in the office action mailed on Jun. 5, 2007, paragraph 10, which are incorporated herein by reference.

10. Claim 5 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of Mikuriya in view of Fukuda, Tamura, Hayashi'687, and Karaki, as evidenced by applicants' admission I, further in view of additional teachings in Tamura.

The claim is rejected for the reasons discussed in the office action mailed on Jun. 5, 2007, paragraph 11, which are incorporated herein by reference.

11. The following rejections are provisional obviousness-type double patenting rejections because the conflicting claims in the cited pending US application have not in fact been patented.

12. Claims 1, 4, and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of US Application 10/900,177 (Application'177), as evidenced by that portion of the disclosure in Application'177 that supports the subject matter recited in the claims of Application'177 and applicants' admission at page 48, lines 20-26, and page 49, lines 12-26, of the instant specification (applicants' admission II), in view of Fukuda, Tamura, Hayashi'687, and Karaki, as evidenced by applicants' admission I.

The examiner notes that the issue fee in Application'177 was filed on Sep. 7, 2007.

The claims are rejected for the reasons discussed in the office action mailed on Jun. 5, 2007, paragraph 13, which are incorporated herein by reference.



13. Claim 5 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of Application'177, as evidenced by that portion of the disclosure in Application'177 that supports the subject matter recited in the claims of Application'177 and applicants' admission II, in view of Fukuda, Tamura, Hayashi'687, and Karaki, as evidenced by applicants' admission I, further in view of additional teachings in Tamura.

The claim is rejected for the reasons discussed in the office action mailed on Jun. 5, 2007, paragraph 14, which are incorporated herein by reference.

14. Applicants' arguments filed on Oct. 5, 2007, applicable to the rejections set forth in paragraphs 9, 10, 12, and 13 above have been fully considered but they are not persuasive.

Applicants state that "[o]nce the art rejection has been formally obviated, Applicants will file appropriate Terminal Disclaimers to resolve the double patenting rejections."

The examiner notes that applicants did not provide any reasons as to why the instantly claimed subject matter is patentable over the claims in Mikuriya or in Application'077 in view of the other cited references.

Because applicants have not filed terminal disclaimers to

Art Unit: 1795

Mikuriya and Application'177, the rejections in paragraphs 9, 10, 13, and 14 stand.

15. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be

Art Unit: 1795

obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Janis L. Dote*  
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Oct. 27, 2007